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NEW YORK, NY 10112

EXAMINER

WALLERSON, MARK E

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

08/579,733

Applicant(s)

NOBUTA ET AL.

Examiner

Mark E. Wallerson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 23 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 24,27,58,59,62 and 63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 24,27,58,59,62 and 63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**Part III DETAILED ACTION**

*Notice to Applicant(s)*

1. This action is responsive to the following communications: amendment filed on **4/23/04 and RCE filed on 6/23/04.**
2. This application has been reconsidered. Claims 24, 27, 29, 58, 59, 62, and 63 are pending.

*Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 24, 27, 62, and 63 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no disclosure in the original specification that the image processing performed by the external computer in the first copying mode is different from the image processing in the second processing mode. The support for this limitation on page 30, lines 16-18 (provided by Applicant) simply states that in that embodiment, the device executes image processing to some

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extent, and the host computer executes specific image processing. There is no disclosure that the image processes are **different**.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 24, 27, 62, and 63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 24, 27, 62, and 63 recite the limitation "the image processing in the second copying mode" in the last line(s) of the claims. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kita (U. S. 5,021,892) in view of Kawamata et. al. (hereinafter referred to as Kawamata) (U. S. 4,989,163).

With respect to claim 27, Kita discloses an image processing device capable of operating in plural modes including a read mode (column 2, lines 47-50); a print mode (column 2, lines 51-53); a first copying mode performed in response to a copying designation by a user (column 5, lines 65-68 and column 6, line 65 to column 7, line 4) and a second copying mode performed in response to a copying designation by a user (column 6, lines 51-55) comprising in the first copying mode, reading an image of a document and outputting an image signal by a scanner (60) (column 3, lines 30-36 and column 5, lines 16-47); a first bidirectional general purpose interface (5) (column 6, lines 20-28) for transmitting the image signal output by the scanner (60) to an external computer (8) (column 5, lines 65-67), which performs necessary image processing on the transmitted image signal (column 3, lines 46-48) to provide a second processed image signal in the first copying mode, and receiving the second processed image signal from the external computer (the data being sent from the computer to the printer would have to pass through interface (5)) (column 5, lines 65-68); a second bidirectional interface (66) (which reads on for connecting a mechanism), for outputting the second signal to a printer (3), and in the second copying mode (which reads on Copy Function) reading an image of a document and outputting an image signal by the scanner (column 5, lines 6-47); performing image processing necessary for copying (printing) on the image signal output by the scanner in a control unit (54) for controlling the image processing to provide a first processed image signal (column 5, lines 31-47), and outputting the first processed image signal to the printer via the bidirectional general purpose interface (column 5, lines 48-56), wherein each of the first and second copying modes is performed in response to a designation of corresponding first and second copying modes (IMAGE INPUT function and COPY function) (column 6, line 50 to column 7, line 7), and

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wherein the image processing performed by the external computer in the first copying mode is different from the image processing in the second copying mode (in the COPY mode, the image scanner (2) reads image data of a document and supplies the image printer (3) with the data (column 6, lines 50-55) – the external computer performs no image processing on this data, while the external computer performs various image on data that is transferred to the external computer (column 3, lines 46-48 and column 5, line 65 to column 6, line 5). See also column 1, lines 34-40.

Kita differs from claim 27 in that he does not clearly disclose that the first and second bidirectional interfaces are of a same standard.

Kawamata discloses a print system wherein all of the interfaces are standardized (column 1, line 67 to column 2, line 4). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kita wherein the first and second bidirectional interfaces are of a same standard. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kita by the teaching of Kawamata in order to increase the processing speed.

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 24, 59, 62, and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kita (U. S. 5,021,892) in view of Kawamata et. al. (hereinafter referred to as Kawamata) (U. S. 4,989,163).

12. With respect to claims 24, 62, and 63, Kita discloses an image processing device (1) comprising a scanner (60) for reading an image of a document and outputting an image signal (column 3, lines 30-36 and column 5, lines 16-47); a control unit (which reads on 50, 51, 52, 54, 56, and buses (DB, AB, and CB)) including a control circuit (50) for controlling the device (column 4, lines 46-54) and performing necessary image processing on the image signal output from the scanner to provide a first processed image signal (column 5, lines 33-37); a first bidirectional general purpose interface (5) (column 6, lines 20-28) for transmitting the image signal input by the scanner (60) under control of the control unit (50) to an external computer (8) (column 5, lines 65-67), which performs necessary image processing on the transmitted image signal (column 3, lines 46-48) to provide a second processed image signal, and receiving the second processed image signal from the external computer (the data being sent from the computer to the printer would have to pass through interface (5)) (column 5, lines 65-68); a second bidirectional interface (66) (which reads on for connecting a mechanism), for outputting the first and second signals to a printer (3), wherein the image processing device (1) has a plurality of modes (column 6, line 50 to column 7, line 25) including a read mode (column 2, lines 47-50); a print mode (column 2, lines 51-53); a first copying mode (which reads on Image Input Function) in response to a copying designation by a user (column 19, lines 23-32) which the image signal outputted from the scanner is outputted to the printer using the external

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computer (8) (column 5, lines 65-68 and column 6, line 65 to column 7, line 7), and a second copying mode (which reads on Copy Function) performed in response to a single user designation (which reads on when the Copy key is depressed) in which the image signal inputted from the scanner is outputted to the printer without using the external computer (column 6, lines 50-55), the image signal output from the scanner being transmitted (which reads on under control of the personal computer or by computer programs) (column 5, lines 65-68; column 6, lines 65-67 and column 23, lines 12-32) in order of control unit (50, 51, 52, 54, 56, and buses (DB, AB, and CB)), first bidirectional interface (5), the external computer (8), the first bidirectional interface (5), the control unit (50, 51, 52, 54, 56, and buses (DB, AB, and CB)), and the second bidirectional interface (66) in the first copying mode (column 5, lines 63-68) based on the second processed signal (which reads on the signal from the computer), and the image signal from said scanner (60) being transmitted in order of the control unit (50, 51, 52, 54, 56, and buses (DB, AB, and CB)) and the second bidirectional interface (66) in the second mode (column 6, lines 51-55) so as to perform copying based on the first processed image signal (which reads on the image signal from the scanner), and wherein the image processing performed by the external computer in the first copying mode is different from the image processing in the second copying mode (in the COPY mode, the image scanner (2) reads image data of a document and supplies the image printer (3) with the data (column 6, lines 50-55) – the external computer performs no image processing on this data, while the external computer performs various image on data that is transferred to the external computer (column 3, lines 46-48 and column 5, line 65 to column 6, line 5). See also column 1, lines 34-40.

Kita differs from claims 24, 62, and 63 in that he does not clearly disclose that the first and second bidirectional interfaces are of a same standard.

Kawamata discloses a print system wherein all of the interfaces are standardized (column 1, line 67 to column 2, line 4). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kita wherein the first and second bidirectional interfaces are of a same standard. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kita by the teaching of Kawamata in order to increase the processing speed.

With respect to claim 59, Kita discloses a density adjusting feature (figure 2, part 25).

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 24, 59, 62, and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kita in view of Menendez (U. S. 5,113,494).

15. With respect to claims 24, 62, and 63, Kita discloses an image processing device (1) comprising a scanner (60) for inputting an image signal (column 5, lines 16-47); a control unit (which reads on 50, 51, 52, 54, 56, and buses (DB, AB, and CB)) including a control circuit (50) for controlling the device (column 4, lines 46-54) and performing necessary image processing on

the image signal input from the scanner to provide a first processed image signal (column 5, lines 33-37); a first bidirectional general purpose interface (5) (column 6, lines 20-28) for transmitting the image signal input by the scanner (60) under control of the control unit (50) to an external computer (8) (column 5, lines 65-67), which performs necessary image processing on the transmitted image signal (column 3, lines 46-48) to provide a second processed image signal, and receiving the second processed image signal from the external computer (the data being sent from the computer to the printer would have to pass through interface (5)) (column 5, lines 65-68); a second bidirectional interface (66) (which reads on for connecting a mechanism), for outputting the first and second signals to a printer (3), wherein the device has a plurality of modes (column 6, line 50 to column 7, line 25) including a first copying mode (which reads on Image Input Function) in which the image signal inputted from the scanner is outputted to the printer using the external computer (8) (column 5, lines 65-68 and column 6, line 65 to column 7, line 7), and a second copying mode (which reads on Copy Function) in which the image signal inputted from the scanner is outputted to the printer without using the external computer (column 6, lines 50-55), the image signal from the scanner being automatically transmitted (which reads on under control of the personal computer or by computer programs) (column 5, lines 65-68; column 6, lines 65-67 and column 23, lines 12-32) in order of control unit (50, 51, 52, 54, 56, and buses (DB, AB, and CB)), first bidirectional interface (5), the external computer (8), the first bidirectional interface (5), the control unit (50, 51, 52, 54, 56, and buses (DB, AB, and CB)), and the second bidirectional interface (66) in the first copying mode (column 5, lines 63-68) based on the second processed signal (which reads on the signal from the computer), and the image signal from said scanner (60) being transmitted in order of the control unit (50, 51, 52, 54, 56, and

buses (DB, AB, and CB)) and the second bidirectional interface (66) in the second mode (column 6, lines 51-55) so as to perform copying based on the first processed image signal (which reads on the image signal from the scanner), and wherein the image processing performed by the external computer in the first copying mode is different from the image processing in the second copying mode (in the COPY mode, the image scanner (2) reads image data of a document and supplies the image printer (3) with the data (column 6, lines 50-55) – the external computer performs no image processing on this data, while the external computer performs various image on data that is transferred to the external computer (column 3, lines 46-48 and column 5, line 65 to column 6, line 5). See also column 1, lines 34-40.

Kita differs from claims 24, 62, and 63 in that he does not clearly disclose that the first and second bidirectional interfaces are of a same standard.

Menendez discloses a print system comprising various nodes (interfaces)  $2_1$  and  $2_{k+1}$  connected to a bus (figure 1) wherein all of the nodes are identical (column 9, lines 41-54). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kita wherein the first and second bidirectional interfaces are of a same standard. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kita by the teaching of Menendez in order to increase the processing speed.

With respect to claim 59, Kita discloses a density adjusting feature (figure 2, part 25).

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kita in view of Kawamata as applied to claim 27 above and further in view of Kochis et. al. (hereinafter referred to as Kochis) (U. S. 5,218,458).

With respect to claim 29, Kita as modified differs from claim 29 in that he does not clearly disclose that the computer has a modem capable of receiving and processing image data from the interface, and transmitting the data to a public telephone line. Kochis discloses a system that transmits a data file between two computer systems via a telephone line (110, figure 1), utilizing PC fax cards (which reads on a modem) (column 2, lines 53-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kita as modified wherein the computer would have a modem capable of receiving and processing image data from the interface, and transmitting the data to a public telephone line. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kita as modified by the teaching of Kochis in order to be able to transfer files between computer systems as taught by Kochis in column 1, lines 6-7.

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claim 58 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kita in view of Kawamata as applied to claim 24 above, and further in view of Kenmochi (U. S. 5,900,947).

With respect to claim 58, Kita as modified differs from claim 58 in that he does not clearly disclose that the scanner generates a color image signal. Kenmochi discloses a communications apparatus wherein a color reading unit may be utilized (column 11, lines 63-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kita as modified wherein the scanner would generate a color image signal. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kita as modified by the teaching of Kenmochi in order to output color data to the personal computer as disclosed by Kenmochi in column 12, lines 1-3.

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claim 58 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kita in view of Menendez as applied to claim 24 above, and further in view of Kenmochi (U. S. 5,900,947).

With respect to claim 58, Kita as modified differs from claim 58 in that he does not clearly disclose that the scanner generates a color image signal. Kenmochi discloses a communications apparatus wherein a color reading unit may be utilized (column 11, lines 63-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kita as modified wherein the scanner would generate a color image signal. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kita as modified by the teaching of Kenmochi in order to output color data to the personal computer as disclosed by Kenmochi in column 12, lines 1-3.

#### *Response to Arguments*

22. Applicant's arguments filed 11/28/2003 have been fully considered but they are not persuasive.

Applicant submits that the cited references do not disclose the image processing performed by the external computer in the first copying mode is different from the image processing in the second copying mode. The Examiner disagrees.

The support for this limitation on page 30, lines 16-18 (provided by Applicant) simply states that in that embodiment, the device executes image processing to some extent, and the host computer executes specific image processing. Kita discloses a COPY function in which image data read by a scanner is transferred to a printer (column 2, lines 29-33). The device alone conducts image processing. In the first mode (INPUT mode) in which image data read by a scanner is transferred to the host (8). This data may be displayed or stored on a disk. Various

image processing may be performed by the host (column 3, lines 46-48), and the data may be transferred to the printer (column 20, lines 54-66). Accordingly, the image processing in the two modes are clearly different.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark E. Wallerson whose telephone number is (703) 305-8581. The examiner can normally be reached on Monday-Friday - 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark E. Wallerson  
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